

Application No. 10/536,729
Amendment Dated September 7, 2006
Reply to Office Action of June 9, 2006

Remarks/Arguments:

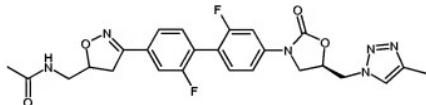
Claims 1, 5-9, 11-13, 15, and 18-23 are pending in the instant application. Applicants have amended claim 1 to correct a grammatical error on page 3 of this Response ("and" was inserted between R_{3a} and R_{5a} in "wherein at least one of R_{3a} R_{5a} is not H;"). No new matter has been added by this amendment.

Rejections under 35 U.S.C. §102(e)

The Examiner rejects claims 1, 7-9, 11-13, 18, and 20-23 under 35 U.S.C. §102(e) as allegedly being anticipated by Gravestock et al., WO 03/022824 (hereinafter, "the '824 Publication").

The Examiner states that "the applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. §102(e). This rejection under 35 U.S.C. §102(e) might be overcome either by showing under 37 C.F.R. 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention 'by another,' or by an appropriate showing under 37 C.F.R. 1.131."

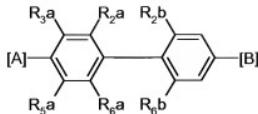
The Examiner further states that Gravestock et al. teach specific compounds of Example 16



of page 67 of the specification, which allegedly read on the instant claims 1, 7-9, 11, 13, 18, and 20-23.¹

Applicants respectfully traverse this rejection. As the Examiner is well aware, for a reference to anticipate a claim, it must teach each and every element of the claim. Applicants respectfully contend that the '824 Publication does not teach each and every element of claim 1 and its dependents.

Claim 1 is directed to "A compound of the formula (I), or a pharmaceutically-acceptable salt, or an in-vivo-hydrolysable ester thereof," of which a portion of formula (I) is represented by

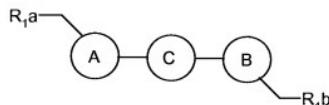


Applicants note that claim 1 requires that "at least one of R₃a and R₅a is not H." To the contrary, the '824 Publication structure shown above is hydrogen substituted in both of the positions corresponding to R₃a and R₅a. Accordingly, '824 Publication structure does not teach each and every element of applicants' claimed invention. Applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Obviousness-Type Double Patenting

The Examiner states that claims 1, 7-9, 11-12, and 18 are provisionally rejected on the ground of nonstatutory double patenting over claims 1-13 and 17 of copending U.S. Application No. 10/489,266. The Examiner further stated that claims 1, 7-9, 11-12, and 18 are provisionally rejected on the ground of nonstatutory double patenting over copending U.S. Application Nos. 10/536,686 and 10/539,482. The Examiner states that these are provisional double patenting rejections since the conflicting claims have not yet been patented.

The Examiner alleges that "the subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter as follows: the compounds and their pharmaceutical formulations of the compounds with the formula:



wherein the substituents are defined in claimed 1 of the three copending applications."

¹ It is respectfully noted that the structure to which the Examiner refers to as corresponding to Example 16 of the '824 Publication is actually that of Example 15. However, Applicants' position is not affected by this.

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Applicants respectfully note that no allowable claims have been identified in the instant application. Accordingly, Applicants submit that the rejection is premature and reserve the right to respond should the rejection be maintained once allowable claims have been identified.

Claim Objections

The Examiner objects to claim 13 under 37 C.F.R. 1.75(c) as being improperly dependent for allegedly failing to limit the subject matter of the base claim. Claim 13 depends from claim 1. Applicants respectfully point out that with the respect to the carbon atom attached to ring B, the structure recited in claim 13 is a particular stereoisomeric configuration of the structure recited in claim 1. Applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

The Examiner objects to claims 5-6, 18, and 20-23 as being dependent on a rejected base claim. Applicants believe that they have overcome the Examiner's rejections of claim 1, from which claims 5-6, 18, and 20-23 directly or indirectly depend, and therefore respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Applicants believe the application is now in condition for allowance, which action is respectfully requested.

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Although Applicants believe no fees are due, the Commissioner is hereby authorized to charge any deficiency in the fees or credit any overpayment to deposit account No. 50-3231, referencing Attorney Docket No. 100869-1P US.

Respectfully submitted,

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